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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,983	10/30/2003	John R. Woods	81168-306630	7854

7590 01/24/2006

Intellectual Property Group of
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EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,983

Applicant(s)

WOODS, JOHN R.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-36, 55 and 56 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 28, 29, 32-36, 55 and 56 is/are rejected.
7) ☒ Claim(s) 30 and 31 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 28-36, 55 and 56 are pending as amended on 30 October 2003.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

3. Applicant is thanked for pointing out the preliminary amendment to the specification referring to the priority claim made to applications 09/746,447 and 09/375,840. The remarks made in the previous Office action regarding priority are withdrawn.

Drawings

4. Applicant's amendment, filed 9 January 2006, with respect to the description of drawing reference number 18 has been fully considered and are corrective.

The objection to the drawings has been withdrawn.

Specification

5. Applicant's amendment, filed 9 January 2006, with respect to the correction of Tradenames has been fully considered and are corrective.

The objection to the specification has been withdrawn.

6. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be

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accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Double Patenting

7. Applicant's terminal disclaimer, filed 9 January 2006, has been fully considered and is proper.

The rejection of claims 28-36, 55 and 56 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,797,051 (Woods '051 hereinafter) has been withdrawn.

8. Applicant's arguments, filed 9 January 2006, particularly that an obviousness-type double patenting rejection over the claims of copending Application No. 10/457,240 is improper as the instant claims and those of the copending application were deemed to be independent and distinct in the restriction requirement filed in the parent Application No. 09/375840, have been fully considered and are persuasive.

The provisional rejection of claims 28-36, 55 and 56 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/457,240 in view of US Patent 4,472,201 (Ochi hereinafter) has been withdrawn.

Claim Rejections - 35 USC § 103

9. The rejections of claims 28, 32, 33, 35, 36, 55 and 56 under 35 USC 103(a) as being unpatentable over US Patent 5,505,344 (Woods '344 hereinafter) in view of Ochi

and US Patent 5,914,196 (Calvo hereinafter), of claim 29 under 35 USC 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo in further view of US 4,450,253 (Suk hereinafter), of claim 29 under 35 USC 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo in further view of US 5,500,456 (Hughett hereinafter) and of claim 34 under 35 USC 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo in further view of US Patent 4,005,038 (Minkoff hereinafter) are maintained. Applicant's arguments filed 9 January 2006 have been fully considered but they are not persuasive.

Applicant argues that Ochi and Woods '344 are neither analogous art nor reasonably related in the problem being addressed; however, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both deal with spray application to walls or ceilings.

Applicant further argues that Ochi has a different reason for adding polyethylene to the composition than applicant; however, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant finally argues that Ochi teaches away from combination of the teachings of Woods '344 and Ochi in that Ochi states that polyethylene is desirable for

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its ability to resist shrinkage and to insulate heat, which would be undesirable in the aerosol spray material of Woods '344; however, Ochi teaches the spraying of their composition, indicating that the polyethylene aggregate would indeed be suitable as a modification to Woods '344's composition (Ochi Column 3 Line 67 – Column 4 Line 5) and Woods '344 is silent as to shrinkage and insulating properties.

Applicant makes no arguments regarding Calvo, Suk, Hughett or Minkoff.

Allowable Subject Matter

10. Claims 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose or fairly suggest the use of a carbonal suspending agent in the composition claimed.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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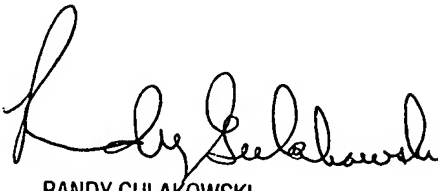
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
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RANDY GULAKOWSKI
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